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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

JP919970025US2RE (L8728-617 RE)

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Application Number

10/615,557

Filed

July 8, 2003

First Named Inventor

Saturo Yamada

Art Unit

2629

Examiner

Kumar, Srilakshmi K.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record. 48,909
Registration number _____

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____



Signature

Nathaniel T. Wallace

Typed or printed name

516-692-8888

Telephone number

September 5, 2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT(S): Saturo Yamada EXAMINER: Kumar, Srilakshmi K.
SER. NO.: 10/615,557 GROUP ART UNIT: 2629
FILED: July 8, 2003 DOCKET: JP919970025US2RE (L8728-617 RE)
FOR: **INFORMATION PROCESSING APPARATUS FOR IMPROVED
INTUITIVE SCROLLING UTILIZING AN ENHANCED CURSOR**

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Examiner:

In response to the Advisory Action dated August 27, 2007, Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal and a Pre-Appeal Brief Request For Review Form (PTO/SB/33).

REMARKS

Please consider the following reasons for this Pre-Appeal Brief Request For Review.

Claims 1-14 are pending in the case. Applicants appreciate the Examiner's indication that Claims 1-8 and 14 are allowed, and that Claims 9 and 13 would be allowable pending resolution of the objection. Thus, only Claims 9 and 13 are addressed here.

Claims 9-13, 15 and 16 have been objected to under 35 USC 112, first paragraph, as failing to comply with the written description requirement. By the Amendment dated April 19, 2007, Claims 9 and 13 were amended to include the limitations of Claims 15 and 16, respectively. The Examiner stated essentially the specification does not teach to one of ordinary skill in the art "that when a third of the three buttons is depressed there is manipulation of the lever input device."

Claim 9 claims, *inter alia*, "to scroll within a displayed window by manipulation of the lever input device when a third of the three buttons is depressed." Claim 13 claims, *inter alia*, "to scroll within a displayed window by manipulation of the lever input device when the middle button is depressed."

Respectfully, the claims do not claim a manipulation of the lever due to the depression of a third or middle button, but rather that a scroll function is operated by manipulation of the lever input device when the third or middle button is depressed. The interpretation proposed in the *Response to Arguments* in the Final Office Action seemingly construes the word "when" to imply more than a correspondence in time or circumstance, for example, to imply that a

manipulation of the lever is a consequence of depressing a button, or that the lever is manipulated by depressing the button. No known definition of the word “when” supports such an interpretation. The words “by” and “when” are believed to be precisely employed in Claims 9 and 13. Therefore, the manipulation of the lever input device when the third or middle button is depressed is believed to be described in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time of the application was filed, has possession of the claimed invention.

Therefore, there are clear errors in rejection under 35 USC 112, first paragraph. Reconsideration of the rejection is respectfully requested.

For the forgoing reasons, the present application, including Claims 1-14, is believed to be in condition for allowance. Early and favorable action is respectfully urged.

Respectfully submitted,

Dated: September 5, 2007

By: /Nathaniel T. Wallace/
Nathaniel T. Wallace
Reg. No. 48,909
Attorney for Applicant(s)

Mailing Address:
F. CHAU & ASSOCIATES, LLC
130 Woodbury Road
Woodbury, New York 11797
TEL: (516) 692-8888
FAX: (516) 692-8889